

REMARKS

In the Office action dated March 11, 2005, claims 1-22, 35-41, 50-54 and 61 were rejected, and claim 61 was objected to. Claims 1-15 and 19-22 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,830,224 ("Cohn '224"). Claims 35, 37, 38, and 40 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,544,230 ("Flaherty '230"). Claims 50 and 52-54 were rejected under 35 U.S.C. 102(e) as being anticipated by Publication No. 2004/0260333 ("Dubrul"). Claims 16 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn '224 in view of Dubrul. Although the Office action identified claim 19, it appears that claim 18 was rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn '224 in view of U.S. Patent No. 5,740,808 ("Panescu '808"). Claim 36 was rejected under 35 U.S.C. 103(a) as being unpatentable over Flaherty '230, in view of U.S. Patent No. 5,601,580 ("Goldberg '580"). Claim 39 was rejected under 35 U.S.C. 103(a) as being unpatentable over Flaherty '230 in view of Cohn '224. Claim 41 was rejected under 35 U.S.C. 103(a) as being unpatentable over Flaherty '230 in view of Dubrul. Claim 51 was rejected under 35 U.S.C. 103(a) as being unpatentable over Dubrul in view of Goldberg '580.

By the present amendment, claims 1, 4, and 35 have been amended. New claims 70-74 have been added, and apparatus claims 55-69 have been canceled without prejudice. Claims 1-22, 35-41, and 50-54 are pending and under consideration in the present application. Claims 23-34 and 42-49 have been withdrawn from consideration. Applicant respectfully requests reconsideration of the present application.

OBJECTIONS TO CLAIMS

Claim 61 was objected to under 37 C.F.R. 1.75(c) for improper dependent form. Claim 61 was dependent on claim 50, but should have been dependent on claim 59 instead. Applicant regrets this typographical error. Claim 61 has been canceled along with other apparatus claims that were withdrawn from consideration as being directed to an unelected species.

The Office action suggested that claim 4 be amended to replace "a" fiber optic device with "the" fiber optic device. Claim 4 has been amended as suggested. Claim 35 has also been amended to correct an apparent typographical error.

REJECTIONS BASED ON DUBRUL

Claims 50 and 52-54 were rejected under Section 102(e) as being anticipated by Dubrul, and claim 51 was rejected under Section 103(a) as being unpatentable over Dubrul in view of Goldberg `580.

Dubrul is a published U.S. patent application having a filing date of April 15, 2004, and claims priority as a continuation-in-part to several prior continuation applications (and which issued as U.S. Patent Nos. 6,699,260 and 6,238,412). Dubrul also claims priority to the prior provisional Patent Application Nos. 60/463,203 (filed on Apr. 16, 2003) and 60/496,811 (filed on Aug. 21, 2003). The portions of Dubrul relied upon in the Office action are not found in the earlier continuation applications (this can be confirmed by reviewing U.S. Patent Nos. 6,699,260 or 6,238,412). Because the relied-upon subject matter is not contained in those earlier patent applications, such

subject matter is not entitled to the earlier filing dates of those earlier applications 35 U.S.C. 102(e). *See* M.P.E.P. 2136.02

Thus, the earliest effective filing date for the relied-upon subject matter in Dubrul is April 16, 2003. Because this is several years after the effective filing date of the present application, the relied-upon subject matter in Dubrul is not as prior art under 35 U.S.C. 102(e). Applicant respectfully submits that the rejection of claims 50-54 should be withdrawn for at least this reason.

In addition, Applicant notes that Dubrul does not disclose the claimed invention. In support of the rejection, paragraphs [0060], [0065], [0067], and [0070] from Dubrul were cited. These paragraphs refer to Figures 59 and 60, 67, 70, and 73 and 74, respectively, in Dubrul. Applicant respectfully submits that none of these figures illustrates a guide wire having a hook-shaped tip. Dubrul instead illustrates and expandable braided device, which may include hooks at the ends of the braid to attach the braid to the blood vessel wall to form an anastomosis (which is the surgical union of the blood vessels to form a continuous channel). This is not the claimed invention.

The Office action also cites paragraphs [0135], [0163], [0165] and [0202-0205] from Dubrul. Paragraph [0135] refers to a funnel catheter 190 having a braided tubular sleeve. Paragraph [0163] refers to "a fastener [for an anastomotic device] made from a deformable material" and that "[t]he material is transformable between a smaller and then larger size, upon application of energy to the material." Paragraph [0165] refers to the use of hooks and other mechanisms in an anastomotic device. Paragraphs [0202-0205] refer to the use of anchor members such as hooks in a tubular braided type of anastomotic

device. None of these passages discloses the claimed use of a guide wire having a hook-shaped tip. In addition, the reference to applying energy in paragraph [0163] of Dubrul is inapposite to the step of "applying energy to the hollow anatomical structure ... until the hollow anatomical structure durably assumes a smaller size," recited in claim 54. Dubrul clearly refers to the application of energy to the deformable material of the fastener, and not to the hollow anatomical structure as required by the claim.

Applicant respectfully submits that the subject matter in Dubrul relied upon in the Office action cannot properly form a Section 102(e) rejection. In any event, notwithstanding the fact that the relied-upon teachings of Dubrul cannot form the basis of a proper Section 102(e) rejection, Dubrul does not disclose the claimed invention as discussed above. Accordingly, Applicant respectfully requests that the rejections of claims 50-54 based on Dubrul be withdrawn.

REJECTIONS BASED ON FLAHERTY '230

Claims 35, 37, 38, and 40 were rejected under Section 102(e) as being anticipated by Flaherty '230. Claim 36 was rejected under Section 103(a) as being unpatentable over Flaherty '230 in view of Goldberg '580. Claim 39 was rejected under Section 103(a) as being unpatentable over Flaherty '230 in view of Cohn '224. Claim 41 was rejected under Section 103(a) as being unpatentable over Flaherty '230 in view of Dubrul.

Flaherty '230 discloses a marker on a tissue penetrating catheter used for bypass procedures. The marker is in alignment with the opening in the catheter through which the tissue penetrating element emerges. Thus the marker is within the blood vessel when

in use. Applicant respectfully submits that Flaherty `230 does not disclose the claimed step of "marking externally the desired location," or the claimed "external marking" recited in independent claim 35. Applicant notes that Claim 35 has been amended only to correct an apparent typographical error. Applicant respectfully requests that the rejections of claims 35-41 based on Flaherty `230 be withdrawn.

REJECTIONS BASED ON COHN `224

Claims 1-15 and 19-22 were rejected under Section 102(b) as being anticipated by Cohn `224; claims 16 and 17 were rejected under Section 103(a) as being unpatentable over Cohn `224 in view of Dubrul; and claim 18 was rejected under Section 103(a) as being unpatentable over Cohn `224 in view of Panescu `808.

Cohn `224 is directed to a catheter for generating a fistula between blood vessels. The fistula would be an abnormal passage that connects the blood vessels. Cohn `224 teaches the use of a pair of catheters in tandem, with each catheter being inserted into each of the blood vessels. *See* Cohn `224 at Abstract and at col. 15, lines 7-32. The catheters are designed to cut tissue. For example, Cohn `224 at col. 25, lines 16-33, discloses the use of laser (light) energy for perforating the vascular wall.

Claim 1 has been amended to recite the additional step of "applying energy to the hollow anatomical structure at the treatment site via an energy application device at the working end of the catheter so as to lead to a reduced diameter for the hollow anatomical structure." Applicant respectfully submits that this feature is not disclosed in Cohn `224 (or the other applied prior art of record). Applicant respectfully submits that the

perforation of blood vessels disclosed in Cohn '224 neither teaches nor suggests the claimed step of applying of energy so as to lead to a reduced diameter of the hollow anatomical structure. Nor is there a proper motivation for one of ordinary skill in the art to combine this claimed feature with the catheter for generating a fistula between blood vessels disclosed in Cohn '224.

Accordingly, Applicant respectfully requests that the rejections of claims 1-22 based on Cohn '224 be withdrawn.

NEW CLAIMS

New claims 70-74 have been added to further define the invention. These new dependent claims recite a step of applying energy so as to lead to a reduced diameter for the hollow anatomical structure. Dependent claims 70, 72 and 74 further recite that the reduced diameter results in occlusion of the hollow anatomical structure. Applicant respectfully submits that new claims 70-74 are allowable.

CONCLUSION

Applicant respectfully submits that the pending claims are allowable, and respectfully requests favorable reconsideration of the present application at an early date.

If the Examiner has any comments or questions regarding any of the foregoing, kindly telephone the undersigned.

Respectfully submitted,

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